

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Agrawal et al.

Atty. Docket No.: ARC920030034US1

Serial No.: 10/624,069

Group Art Unit: 2161

Filed: July 21, 2003

Examiner: Padmanabhan, Kavita

For: MINING ASSOCIATION RULES OVER PRIVACY PRESERVING DATA

PETITION UNDER 37 C.F.R. §1.147(a) TO PERMIT ACCEPTANCE OF 37 C.F.R. AFFIDAVIT WITHOUT THE SIGNATURE OF ONE OF THE**INVENTORS**

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Director of the USPTO
P.O. Box 1450
Alexandria, VA 22313-1450
Sir:

Applicants hereby petition the Director to accept the 37 C.F.R. §1.131 declaration submitted as ATTACHMENT A with the simultaneously filed submission in support of the request for continued examination under 37 C.F.R. §1.114. The 37 C.F.R. §1.131 declaration has been signed by two of the joint inventors of the present invention, namely, Alexandre Evfimievski and Ramakrishnan Srikant. Another of the joint inventors (Rakesh Agrawal) was at the time of the invention and at the time the present patent application was filed, an employee of the assignee, International Business Machines, Inc. However, Rakesh Agrawal no longer works for International Business Machines, Inc. and has refused to sign a 37 C.F.R. §1.131 declaration, which is necessary to overcome a prior art rejection.

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Adjustment date: 08/01/2008 CKHLOK
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Per the requirements of 37 C.F.R. §1.147(a), the Applicants also submit that the last known work and home addresses of the non-signing inventor, Rakesh Aggrawal, was as follows:

Work:
Microsoft Research Labs
1065 La Avenida
Mountain View, CA 94043

Home:
1290 Quail Creek Circle
San Jose, CA 95120

Per the requirements of 37 C.F.R. §1.147(a), the Applicants provide the attached statement (ATTACHMENT (a)) of Van Nguy, an attorney at the IBM Almaden Research Center in San Jose, California, along with copies of email correspondence between Van Nguy and Rakesh Aggrawal (EXHIBITS (1)-(16) to Attachment (a)). The statement and emails show Van Nguy presented Rakesh Aggrawal with three different versions of a 37 C.F.R. §1.131 declaration for his signature and that he refused to sign all three of the different versions.

Also provided in support of Van Nguy's statement are copies of the three different versions of the 37 C.F.R. §1.131 declaration presented to Rakesh Aggrawal by Van Nguy for his signature (see Attachments (b)-(d)). Attachment (b) differed from the executed declaration of Alexandre Evfimievski and Ramakrishnan Srikant only slightly. For example, Attachment (b) used the phrase "earliest effective prior art date", rather than the actual August 2002 date of Rizvi. Additionally, Attachment (b) contained the

statement “During all time periods mentioned herein and, specifically, between the conception date and the filing date of the Patent Application, all activities described herein occurred in the United States.”

Attachments (c) and (d) differed from the executed declaration of Alexandre Evfimievski and Ramakrishnan Srikant in that they were significantly shorter per Rakesh Agrawal’s request. For example, Attachments (c) and (d) did not contain the listing of independent claims with reference to the exemplary locations within “Privacy Preserving Mining of Association Rules” (July 2002) (i.e., the published article of the inventors upon which the present application was based), wherein the claimed features are described. This listing was provided in the original version of the declaration presented to Rakesh Agrawal (i.e., Attachment (a)) and was retained in the executed declaration of Alexandre Evfimievski and Ramakrishnan Srikant.

The Applicants submit that the statement of Van Nguy, as well as the other evidence provided, clearly indicate that Rakesh Agrawal is unwilling to or unable to continue to join in the prosecution of the present application. His refusal to sign a 37 C.F.R. §1.131 affidavit was not based on a difference of opinion as to the facts of the case, but rather on Rakesh Agrawal’s misunderstanding of the requirements of a 37 C.F.R. §1.131 affidavit and, more specifically, his belief, despite efforts to persuade him otherwise, that a statement claiming that “our invention was done before July 2002” would be sufficient. Therefore, the Applicants respectfully request that the executed declaration of Alexandre Evfimievski and Ramakrishnan Srikant without the signature of

Rakesh Agrawal be accepted for purposes of establishing prior invention under 37 C.F.R.

§1.131, as failure to do so will result in irreparable damage to the remaining inventors.

Please charge the petition fee under §1.17(g) of \$200.00 for a §1.147 petition and any other fees required to Attorney's Deposit Account No. 09-0441.

Respectfully submitted,

Dated: 7/3/08

/Pamela M. Riley/

Pamela M. Riley

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